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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/075,283

02/15/2002

Makoto Iwayama

9044

24956

7590

05/05/2006

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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT

PAPER NUMBER

2165

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/075,283

Applicant(s)

IWAYAMA ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### Remarks

1. The After-Final Amendment filed on 11-April-2006 has been received and entered.

Claims 10-18 are now pending.

### *Claim Objections*

2. Claims 11-17 are objected to because of the following informalities:

Each of these dependent claims start with "A service...as defined in claim 10". As such it indicates a new instance of each not dependent on the parent claim. Claims should be amended to recite "The service... as defined in claim 10". Appropriate correction is required.

Claims 10-17 are objected to because of the following informalities:

Claims 10, 11, 17, all carry intended use recitation of "**for**" performing a function.

For Example, claim 10, line 19, recite "a second search input **for** performing" which constitute intended use and does not carry patentable weight since it never has to occur. The claim should be amended to recite more firm and positive language (i.e. "is", "that", "wherein" or "configured to").

Claim 11, line 6, recite "search input for searching" which constitute intended use and does not carry patentable weight since it never has to occur. The claim should be amended to recite more firm and positive language (i.e. "is", "that", "wherein" or "configured to").

Claim 17, line 3, recite “an interface for selecting” which constitute intended use and does not carry patentable weight since it never has to occur. The claim should be amended to recite more firm and positive language (i.e. “is”, “that”, “wherein” or “configured to”).

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 10-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 10, and 18 preamble recite “A service **for** searching” the limitations following the phrase “**for**” describes only intended use but not necessarily required functionality of the claim. Limitations following the phrase “**for**” do not carry patentable weight, which cause the claims to appear as a series of non-functional descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form.

In claim 10, “inputting to a first document”... “making a weighted” and “performing a search” do not have to functionally to be tied to together in a storage system. They do not have to be of a service in a networked environment and do not have to be used to perform the stated functionality. They do not have to actually take place. A claim must be directed to a series of steps preformed in a computer or computer implemented or contains positive recitation such as “is” or “that” or “a computer implemented service of searching documents”

Claim 10, although, reciting “A service **for** searching” in the preamble, there is no mention of a computer or any processing taking place in either the preamble nor in the body of the claim in order for the steps to be stored or transformed and realized its functionality (on a computer or any other hardware). There’s no other mention of the service in the body of the claim and no indication as to what is meant by the service indicating merely a functionality and not hardware. Furthermore, there is no tangible embodiment of any hardware tied to limitations of the claim because how can a “service” inputs, makes, and performs a search without the help of a computerized device?

Similarly claim 18 have the same deficiency. Correction is required.

Claims 11-17 all start with the intended use recitation of “A service **for** searching” therefore carry the same deficiency.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13, 15, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13, line 2 recite “a client” again, although claim 10’s preamble of which claim 13 depends has already introduced the recitation of “a client”. Is this a separate new client or the

same initial client and if so, the claim should be amended to recite “the” or “said” to indicate such reference.

Similarly, claim 15, line 2 carry the same deficiency.

Claim 15, recite “a server” in line 7, again although previously introduced the same recitation in line 3, is this a new server being referenced or the same initial server, if so, the claim should be amended to recite “said” or “the” to eliminate lack of antecedent basis.

Similarly, claim 17, line 5 carry the same deficiency.

7. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention since the claim does not distinct the preamble from the body of the claims.

Examiner is unclear on what is the claimed invention.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 10, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Spencer (U.S. Patent No. 5,826,261).

As to claim 10, Spencer discloses a service for searching documents wherein servers comprising document databases and programs to manipulate said databases are dispersed over a network and a client connected to said servers performs a document search, said service providing a document search method comprising the steps of:

inputting, to a first document database, at least one document retrieved as a result of a first search of said first document database; wherein the first search is conducted by a first search input, to said first document database, of a set of keywords, fragments of document or any desired set of documents (See column 6, lines 1-5, also see column 12, lines 49-67, wherein “result of first search” reads on “first list of terms” are returned to the client in response to first query),

making a weighted term list from said input of said at least one document to said first document database, the weight of each term reflecting the importance of the term in the first document database (See column 13, lines 20-25), and

performing a search of a second document database; wherein said weighted term list is used as a second search input for performing said search of said second document database (See column 6, lines 6-8, and see column 13, lines 35-45), and

wherein each term in the term list is weighted considering the importance of the term both in the first document database and the second document database, and the weight being used to calculate the relevance of each document of the second document database (See column 6, lines 20-27, and see column 14, lines 52-62).

As to claim 18, (rejected as best ability under with respect to 1122<sup>nd</sup>) Spencer discloses a service for searching documents wherein servers comprising document databases and programs to manipulate said databases are dispersed over a network and a client connected to said servers performs a document search,

said service providing a document search method in which the client transmits a set of documents in a first search input to one of said servers where a first document database is stored, receives a summary comprising only topic words related to the set of documents which is sent (See column 6, lines 1-5, also see column 12, lines 49-67, wherein “result of first search” reads on “first list of terms” are returned to the client in response to first query, and wherein “summary” reads on matching “terms” in results),

sends a second search input corresponding to said summary reflecting a user's evaluation of the summary to a server where a second document database is stored (See column 13, lines 20-25), and

receives a search result from the search of the second document database, wherein said server storing the first document database produces the summary of topic words relevant to the set of documents sent by the client and transmits the summary to the client, and searches and transmits a set of documents having a high relevance to any desired summary sent by the client, to the client (See column 6, lines 6-8, also column 6, lines 20-27, and column 13, lines 35-45, and column 14, lines 52-62).

***Allowable Subject Matter***



10. Although no rejections in view of prior art are made with regards to dependent claims 11-17, no claims in this application will be indicated as allowable until after a response to this action has been reviewed, as to the fact that certain changes may not produce allowable claims.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 10-18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Neveen Abel-Jalil

May 1, 2006